

## **R E M A R K S**

The office action of March 25, 2003 has been reviewed and its contents carefully noted. Reconsideration of this case, as amended, is requested. Claims 1-34 remain in this case, claims X being amended by this response.

The numbered paragraphs below correspond to the numbered paragraphs in the Office Action.

### **The Restriction Requirement**

1. The Examiner made the restriction requirement final. The Examiner supported this decision by stating that the criteria the Applicant discussed in the Office Action response dated January 9, 2003 was not the proper criteria to be used, since it was an election of species requirement, and not a restriction requirement.

However, the Applicant specifically discussed an election of species requirement in the last office action response. "Furthermore, when electing species, 'where there is a relationship disclosed between species, such disclosed relation must be discussed and reasons advanced leading to the conclusion that the disclosed relation does not prevent restriction, in order to establish the propriety of restriction.' (M.P.E.P. 808.01(a)). The Examiner neither discusses the disclosed relation or the reasons advanced leading to the conclusion that the relation should not prevent restriction. Therefore, the restriction is improper." (Office Action response dated January 9, 2003, page 3, third paragraph). Therefore, the Applicant respectfully requests that the Examiner comply with the requirement that the Examiner advance reasons why the relationship between the species does not prevent restriction.

2. The Examiner states that, since Fig. 14 does not contain a saddle stem (as recited in independent claims 1, 29, and 32), that only claim 33 reads on the elected species. Applicant respectfully disagrees.

Claim 33, which reads, "[a] labeling device intended for use on a circular pipe, tube, or conduit, comprising: a sign plate; and a saddle fitting integrally molded to said sign plate, wherein an inside diameter of said saddle fitting is shaped as a section of a circle having a gap of

less than 180°, such that when applied to a pipe, tube, or conduit having an outside diameter and an axial length, said inside diameter of said saddle fitting is equal to or slightly smaller than said outside diameter of said pipe, tube or conduit and the inside diameter of said saddle fitting is in contact with the outside diameter of said pipe, tube, or conduit”, is a generic claim. The labeling device of claim 33 comprises a sign plate and a saddle fitting. This language does not obviate the addition of other components of the labeler. The labeling device could additionally have a saddle stem (as recited in independent claims 1, 29, and 32). Basically, the other independent claims could be written to be dependent upon claim 33. Because the claims were written to be independent rather than dependent does not change the fact that claim 33 is generic to those claims.

The labeling device in claim 1, for example, comprises a sign plate and a saddle fitting. In addition, it also comprises a saddle stem connected to the sign plate and the saddle fitting. The labeling device of claim 33, which comprises a sign plate and a saddle fitting (and the comprising language indicates that other components of the pipe labeler are also encompassed by the claim), is clearly generic as it relates to claim 1. It is also generic as it relates to independent claims 29 and 32. Therefore, claims 1-29 and 32 should also be examined.

### **Priority**

3. The Examiner stated the priority information should include the status of the parent application. The specification has been amended to comply with this requirement.

### **Information Disclosure Statement**

5. The Examiner did not consider German publication #633468, because the Applicant did not explain the foreign publication's relevance in the Information Disclosure Statement.

The Applicant cited this publication because it was cited by the Examiner in the related, parent application. Attached are copies of the Office Action dated July 5, 2000, where the German publication was cited by the Examiner. Specifically, Examiner Silberman included the German publication in her conclusion on page 4, last paragraph of the Office Action dated July 5, 2000. It is listed with numerous other publications, and Ms. Silberman states that “[t]he prior art of record and not relied upon is considered pertinent to applicant's disclosure... German

application 633468... [is] cited as of interest." (Office Action for 09/233,397 dated July 5, 2000, page 4, last paragraph). The Applicant has satisfied his duty to disclose by including this patent cited in the related application. The Applicant has no further duty to translate or state whether or how this publication is relevant.

### **Specification**

6. The Examiner objected to the abstract of the disclosure. The abstract has been amended to overcome this objection. Specifically, the means language has been removed from the Abstract. In addition, although not requested by the Examiner, the Abstract has been reduced to less than 150 words, in compliance with 37 CFR 1.72(b). Reconsideration and withdrawal of the objection is respectfully requested.

### **Rejection under 35 U.S.C. §102**

8. Claim 33 was rejected under 35 U.S.C. 102 as being unpatentable over Clement (US Patent No. 4,844,000). Applicant respectfully disagrees.

"Unless all of the same elements are found in exactly the same situation and united in the same way to perform the identical function in prior pleaded art, there is no anticipation."  
*Stauffer v. Slenderella Systems of California, Inc.*, 254 F.2d 127, 115 USPQ 347 (9th Cir. 1957).

Claim 33 recites a sign plate and a saddle fitting. Clement teaches a saddle fitting but does not teach the sign plate of the present invention. The present application discusses at length the problems with providing labels on pipes directly or on curved surfaces. (See generally, pages 1-3 of the present application). Apparently, the Examiner is reading the directional fingers of Clement to be equivalent to the "sign plates" disclosed by the applicant and recited in claim 33. Claim 33 has been amended to more clearly recite the structural requirement that the sign plate provide a "flat surface" that is above the saddle fitting. For support, please note page 3, line 29 of the present application and generally every figure in the application.

The invention recited in claim 33 is not obvious in view of Clement either. Clement's structure does not solve the problems of the prior art and, more importantly, the sign plate of the present invention does. The present invention allows clear and easy labeling of pipes by

providing a flat sign plate for writing or other form of labeling that connects to the pipe by a saddle fitting. Clement's fingers or exit markers are right up against the fire hose. That may be fine for the application, but for the present invention that may be used on steam pipes conveying hot materials, it is much better to have the sign plate away from the pipe. As shown in Figure 14, a large portion of the flat surface of the sign plate is well away from the pipe.

### Conclusion

Applicant believes the claims, as amended, are patentable over the prior art, and that this case is now in condition for allowance of all claims therein. Such action is thus respectfully requested. If the Examiner disagrees, or believes for any other reason that direct contact with Applicants' attorney would advance the prosecution of the case to finality, he is invited to telephone the undersigned at the number given below.

"Recognizing that Internet communications are not secured, I hereby authorize the PTO to communicate with me concerning any subject matter of this application by electronic mail. I understand that a copy of these communications will be made of record in the application file."

Respectfully Submitted:  
*Boire et al.*

By: 

Christopher A. Michaels, Reg. No. 34,390  
Agent for Applicant

BROWN & MICHAELS, P.C.  
400 M&T Bank Building - 118 N. Tioga St.  
Ithaca, NY 14850  
(607) 256-2000 • (607) 273-2609 (fax)  
e-mail: [michaels@bpmlegal.com](mailto:michaels@bpmlegal.com)  
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